

REMARKS

Claims 1 through 7 are pending in this Application. Claims 1, 4, and 5 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 6 of the written description of the specification line 5 through page 7, line 1. Moreover, the present Amendment is consistent with Applicants' right to restrict an originally disclosed invention. *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). Applicants submit that the present Amendment does not generate any new matter issue.

In the August 20, 2003 Office Action, the Examiner imposed the following rejections:

- 1. Claim 1 was rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Osaka et al.;**
- 2. Claims 3, 4, and 6 were rejected under 35 U.S.C. §103 for obviousness predicated upon Osaka et al.;**
- 3. Claim 2 was rejected under 35 U.S.C. §103 for obviousness predicated upon Osaka et al. in view of O'Toole et al.; and**
- 4. Claims 5 and 7 were rejected under 35 §103 for obviousness predicated upon Osaka et al. in view of O'Toole et al.**

Each of the above rejections is traversed. Specifically, each of independent claims 1, 4, and 5 is directed to a method comprising manipulative steps which include heating a portion including an adjacent end face of the first optical fiber to diffuse a dopant, followed

by connecting the first and second optical fibers by fusion-splicing, wherein **only** the first optical fiber is heated before connecting the first and second optical fibers. This sequence of manipulative steps is neither disclosed nor suggested by Osaka et al. Indeed, it should be apparent from Fig. 1 of Osaka et al., that step two requires heating **both end parts** before fusion-splicing. Moreover, the teaching by Osaka et al. to heat both end parts of the fibers to be spliced constitutes a **teaching away** from the claimed invention which denotes patentability.

The above argued difference in manipulative steps between the invention defined in claim 1 (or claims 4 and 5) and the method disclosed by Osaka et al. undermines the factual determination that Osaka et al. disclose a method identically corresponding to that defined in claim 1 within the meaning of 35 U.S.C. §102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Claims 2 and 3 depend from independent claim 1. The Examiner's additional comments with respect to claim 3 and the secondary reference to O'Toole et al. do not cure the argued deficiencies of Osaka et al.

Moreover, there is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to deviate from the expressed teachings of Osaka et al. and heat only the first optical fiber before connecting the first and second optical fibers by fusion-splicing. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Indeed, the Examiner's comments with respect to the second enumerated rejection above and O'Toole et al. do not provide any such motivation. As previously pointed out, the **expressed teaching away** from the claimed invention by

Osaka et al. constitutes a potent indicium of **nonobviousness** as to the rejections under 35 U.S.C. §103. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

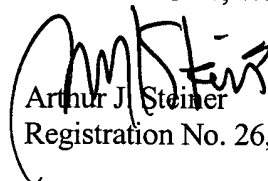
Applicants, therefore, submit that each of the above enumerated rejections 1 through 4 is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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